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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,290	05/19/2000	Naozumi Takenaka	13700	1281

23370 7590 04/28/2003

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EXAMINER

TODD, GREGORY G

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 04/28/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,290

Applicant(s)

TAKENAKA ET AL.

Examiner

Gregory G Todd

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a first office action in response to application filed, with the above serial number, on 19 May 2000 in which claims 1-8 are presented for examination. Claims 1-8 are therefore pending in the application.

#### ***Specification***

1. The disclosure is objected to because of the following informalities: The disclosure contains numerous grammatical errors such as "can be enter" (page 1, line 28), "tries an access to" (page 1, line 30), etc.

Appropriate correction is required.

2. The disclosure is objected to because of the following informalities: The abstract should properly explicitly disclose the information in abbreviations, eg. TSI (Trusted Site Indicator).

Appropriate correction is required.

#### ***Claim Objections***

3. Claims 2, 4 is objected to because of the following informalities: In lines 17 and 8, respectively, "comprising:" is suggested to be replaced with --comprises:--.

Appropriate correction is required.

4. Claim 3 objected to because of the following informalities: In line 36, "has send" is suggested to be replaced with --has sent--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The specified mark, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The disclosure discloses a specified mark as being a "(Trusted Site Indicator tag)" along with "specified data (Trusted Site Indicator data)". However, one of ordinary skill in the art is not able to determine and define a Trusted Site Indicator and how to interpret this into the claims. The terminology of an indicator tag is also vague, wherein the indicator would act as a tag.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The communication carrier receiving information from a computer network and the server sending the information to a computer network is vague as it does not disclose where the information is going to / coming from, such as an address.

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9. Claim 3 recites the limitation "the specified data" in line 35. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Step c could be interpreted as receiving any information from a network, however it is interpreted as receiving the same information including a specified mark from said server.

11. Claim 3 recites the limitation "the proprietary display area" in line 1. There is insufficient antecedent basis for this limitation in the claim.

12. Claims 1, 5, 6 and 7 are objected to because of the following informalities: The terminology "can not" is suggested to be replaced with --cannot--. Appropriate correction is required.

13. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Wherein "the display area cannot be edited by an unauthorized person", it is unclear how the physical display area would or would not be "edited".

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroya et al (hereinafter "Hiroya", 5,754,654) in view of Geiger et al (hereinafter "Geiger", 6,463,534).

16. As per Claim 1, Hiroya discloses a service providing system for verifying a source of information, wherein Hiroya discloses:

(a) a computer network (at least col. 16, lines 49-57; col. 17, lines 6-12);

(b) sending information including a specified mark to the computer network (ticket publisher with electronic signature) (at least col. 15, lines 38-60);

(c) a communication carrier (ticket vending and refunding device) connected to the computer network and adding, when information received from the computer network includes the specified mark, specified data identifying a server which has sent the information to the information (transaction number from publisher being produced and appended) (at least col. 15, lines 13-37; Fig. 8-9); and

(d) a mobile device (at least col. 11, lines 54-60) provided with a proprietary display area which can not be edited by an unauthorized person, making wireless communication with the communication carrier and displaying the specified data on the proprietary display area when receiving information includes the specified data (at least Fig. 4; col. 18, lines 49-58, 36-42).

Hiroya does not explicitly disclose connecting to a server over a network.

However, the use and advantages for using such a client/server and network approach

is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Geiger. Geiger discloses a mobile device connecting over a wireless network to a landline network for connecting to an authenticating server (at least Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Geiger's server and network approach into Hiroya's system as this would allow Hiroya's static ticket system to be completely mobile.

17. As per Claim 2.

wherein the communication carrier comprises:

(i) a database (storage device) for storing the specified data to identify the server in correspondence with a unique address (publisher's name) of the server on the computer network (at least Fig. 2, 9);

(ii) a detection portion for detecting the specified mark (comparing signature using public key) (at least col. 16, lines 1-12);

(iii) an acquisition portion for acquiring the specified data to identify the information sending server by referring to the address of the information sending server when the specified mark is detected (using key storage to validate key in signature / match being found) (at least Fig. 2, 9; col. 16, lines 13-34); and

(iv) an addition portion for adding the specified data as acquired to the information as received (transaction number, publisher name, etc from publisher being produced and appended) (at least col. 15, lines 13-37; Fig. 8-9).

Hiroya does not explicitly disclose using the server address to identify a source of information. However, the use and advantages for using such a IP address is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Geiger. Geiger discloses validating a server is an address is known (at least col. 16, lines 26-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Geiger's server address to identify Hiroya's publisher server as this would further enhance security and authentication.

18. As per Claim 3, Hiroya discloses a service providing system for verifying a source of information, wherein Hiroya discloses:

(a) a computer network (at least col. 16, lines 49-57; col. 17, lines 6-12);

(b) at least one server connected to the computer network and sending information including a specified mark to the computer network (ticket publisher with electronic signature) (at least col. 15, lines 38-60);

(c) a communication carrier (ticket vending and refunding device) connected to the computer network and receiving information from the computer network (reception) (at least col. 15, lines 13-37; Fig. 8-9); and

(d) a mobile device (at least col. 11, lines 54-60) provided with a proprietary display area which can not be edited by an unauthorized person, making wireless communication with the communication carrier, acquiring the specified data which identifies the server which has sent the information (using key storage to validate key in signature / match being found; Fig. 2, 9; col. 16, lines 13-34) and displaying the



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specified data on the proprietary display area when the information as received from the communication carrier includes the specified data (at least Fig. 4; col. 18, lines 49-58, 36-42).

Hiroya does not explicitly disclose connecting to a server over a network. However, the use and advantages for using such a client/server and network approach is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Geiger. Geiger discloses a mobile device connecting over a wireless network to a landline network for connecting to an authenticating server (at least Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Geiger's server and network approach into Hiroya's system as this would allow Hiroya's static ticket system to be completely mobile.

19. As per Claim 4.

wherein the computer network is connected to a database for storing the specified data to identify the server in correspondence with an address of the server on the computer network (at least Fig. 2, 9); and

wherein the mobile device comprises:

(i) a detection portion for detecting the specified mark (comparing signature using public key) (at least col. 16, lines 1-12); and

(ii) an acquisition portion for acquiring the specified data to identify the information sending server by referring to the address of the information sending server when the

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specified mark is detected (using key storage to validate key in signature / match being found) (at least Fig. 2, 9; col. 16, lines 13-34).

Hiroya does not explicitly disclose using the unique server address to identify a source of information. However, the use and advantages for using such a IP address is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Geiger. Geiger discloses validating a server is an address is known (at least col. 16, lines 26-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Geiger's server address to identify Hiroya's publisher server as this would further enhance security and authentication.

20. As per Claim 5, Hiroya discloses a service providing method for verifying a source of information, wherein Hiroya discloses:

(a) receiving information including a specified mark from a server connected to a computer network (receiving electronic signature from ticket publisher) (at least col. 15, lines 38-60);

(b) detecting the specified mark from the information as received (comparing signature using public key) (at least col. 16, lines 1-12);

(c) acquiring a specified data for identifying the server when the specified mark is detected (using key storage to validate key in signature / match being found) (at least Fig. 2, 9; col. 16, lines 13-34);

(d) adding the specified data to the information (transaction number, publisher name, etc from publisher being produced and appended) (at least col. 15, lines 13-37; Fig. 8-9);

(e) receiving the information including the specified data by means of a mobile device (at least col. 11, lines 54-60) of a user (at least Fig. 4; col. 18, lines 49-58, 36-42).; and

(f) displaying the specified data under a condition that the specified data can not be edited by an unauthorized person (at least Fig. 4; col. 18, lines 49-58, 36-42).

Hiroya does not explicitly disclose connecting to a server over a computer network. However, the use and advantages for using such a client/server and network approach is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Geiger. Geiger discloses a mobile device connecting over a wireless network to a landline network for connecting to an authenticating server (at least Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Geiger's server and network approach into Hiroya's system as this would allow Hiroya's static ticket system to be completely mobile.

21. As per Claim 6, Hiroya discloses a service providing method for verifying a source of information, wherein Hiroya discloses:

(a) receiving information including a specified mark from a server connected to a computer network by means of a mobile device of a user (receiving electronic signature from ticket publisher) (at least col. 15, lines 38-60);

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(b) detecting the specified mark from the information as received (comparing signature using public key) (at least col. 16, lines 1-12);

(c) acquiring a specified data for identifying the server, when the specified mark is detected, through the mobile device (using key storage to validate key in signature / match being found) (at least Fig. 2, 9; col. 16, lines 13-34);

(d) displaying the specified data to the user through the mobile device (at least col. 11, lines 54-60) under a condition that the specified data can not be edited by an unauthorized person (at least Fig. 4; col. 18, lines 49-58, 36-42).

Hiroya does not explicitly disclose connecting to a server over a network. However, the use and advantages for using such a client/server and network approach is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Geiger. Geiger discloses a mobile device connecting over a wireless network to a landline network for connecting to an authenticating server (at least Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Geiger's server and network approach into Hiroya's system as this would allow Hiroya's static ticket system to be completely mobile.

22. As per Claim 7, Hiroya discloses a mobile device used in a service providing system for verifying a source of information, wherein Hiroya discloses:

(a) a receiver portion for receiving information including a specified mark from a server connected to a computer network through wireless communication (receiving

electronic signature from ticket publisher) (at least col. 15, lines 38-60; at least col. 11, lines 54-60);

(b) a detection portion for detecting the specified mark from the information as received (comparing signature using public key) (at least col. 16, lines 1-12);

(c) an acquisition portion for acquiring a specified data for identifying the server when the specified mark is detected (using key storage to validate key in signature / match being found) (at least Fig. 2, 9; col. 16, lines 13-34);

(d) a proprietary display area for displaying the specified data under a condition that the specified data can not be edited by an unauthorized person (at least Fig. 4; col. 18, lines 49-58, 36-42).

Hiroya does not explicitly disclose connecting to a server over a network. However, the use and advantages for using such a client/server and network approach is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Geiger. Geiger discloses a mobile device connecting over a wireless network to a landline network for connecting to an authenticating server (at least Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Geiger's server and network approach into Hiroya's system as this would allow Hiroya's static ticket system to be completely mobile.

23. As per Claim 8.

wherein the specified data on the proprietary display area is visually identifiable (at least Fig. 17).

**Conclusion**

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

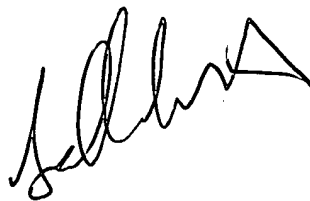
Katz et al (portable device downloading over network), Ramasubramani et al (mobile digital certificate management system), Kawan (wireless transaction system), Talati et al (mobile e-commerce system), Hultgren (mobile station secure payment), and Valtanen (networked ticket purchasing system) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory G Todd whose telephone number is (703)305-5343. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703)308-7562. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

gt  
April 17, 2003



SALEH NAJJAR  
PRIMARY EXAMINER